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10/028,253	12/21/2001	Thomas N. Turba	RA5407 (33012/325/101)	2115

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EXAMINER
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ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/028,253

Applicant(s)

TURBA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Remarks

1. The Amendment filed on October 3, 2005 has been received and entered. Claims 1-25 are pending.

### *Double Patenting*

2. 35 U.S.C. 101 reads as follows:  
  
"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
3. Claims 1-25 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending application Serial No. 10/027,066 and that of claims 1-25 of copending application Serial No. 10/028,256. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 C.F.R. 1.78(d).

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11, 16-21, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth (U.S. Pub. No. 2003/0041053 A1).

As to claim 1, Roth discloses in a data processing system including a legacy data base management system having a command language coupled to a publicly accessible digital data communication network, the improvement comprising:

a. a user terminal (See page 7, paragraph 0087, wherein “terminal” reads on “client computer”) coupled to said legacy data base management system (See pages 2-3, paragraphs 0020-0021) via said publicly accessible digital data communication network (See pages 3, paragraph 0044, wherein “publicly accessible digital data communication network” reads on “Internet” deemed to connect the client-server);

b. a service request generated by said user terminal transferred to said legacy data base management system for honoring (See page 7, paragraphs 0085-0086, wherein “service request”

is accessing the relational database to perform a search, wherein “legacy data base management system” is deemed to run on SQL relational database for database management); and

c. a facility located with said user terminal which inserts a call to native script into said service request (See Figure 6, 508, shows “SQL Statement Generation Module” stored on a client terminal making a request to relational database, also see page 2, paragraph 0020).

As to claim 2, Roth discloses wherein said native script further comprises said command language (See page 3, paragraph 0023, wherein “command language” reads on “SQL”).

As to claims 3, and 25, Roth discloses wherein said service request further comprises an XML message (See page 4, paragraph 0056, wherein “XML send/receive” deemed to include an XML message).

As to claims 4, and 8, Roth discloses comprising storing said native script in a repository located within said legacy data base management system (See Figure 5, 508, shows “native script” represented by “SQL Statements”, 150, shows “legacy database management system” deemed to be part of “server computer”).

As to claims 5, 10, and 19, Roth discloses wherein said publicly accessible digital data communication network further comprises the Internet (See pages 3, paragraph 0044).

As to claim 6, Roth discloses an apparatus comprising:

- a. a publicly accessible digital data communication network (See pages 3, paragraph 0044, wherein the client-server are deemed to be connected over a network-Internet);
- b. a legacy database management system having an internal format different from XML responsively coupled to said publicly accessible digital data communication network (See Figure 6, 160, shows relational database residing within the server computer receiving requests in SQL Not XML, wherein “legacy database management system” is deemed to run on the relational database);
- c. an XML message transferred to said data base management system via said publicly accessible digital data communication network (See page 4, paragraph 0056, lines 1-5, also see page 3, paragraph 0044, deemed to show client server connection via Internet, Figure 6, shows “legacy data base management system” deemed to be implemented on a “relational database”);
- d. a converter which translates said XML message into said internal format (See page 7, paragraph 0089, wherein “internal format” reads on “SQL”); and
- e. a module which embeds native script into a service responding to said XML message translated into said internal format (See page 7, paragraphs 0088-0089, wherein “internal format” reads on “SQL”, also see Figure 6, shows “XML Translator” to “SQL statements” stored in a client terminal and performing a search on a relational database stored remotely in a server).

As to claim 7, Roth discloses wherein said native script further comprises said internal format (See Roth page 2, paragraph 0013, also see Roth page 7, paragraph 0086, wherein “internal format” reads on “SQL”).

As to claim 9, Roth discloses comprising a response produced by said legacy data base management system (See Figure 6, 160, shows relational database residing within the server computer receiving requests and sending responses, wherein “legacy database management system” is deemed to run on the relational database).

As to claim 11, Roth discloses a method of supplying an input to a legacy data base management system having an internal format different from XML format comprising:

a. transferring an XML document having a call to native script to said legacy data base management system via a publicly accessible digital data communication network (See page 4, paragraph 0056, lines 1-5, also see page 3, paragraph 0044, deemed to show client server connection via Internet, Figure 6, shows “legacy data base management system” deemed to be implemented on a “relational database”);

b. converting said XML document into said internal format (See page 7, paragraph 0089, wherein “internal format” reads on “SQL”);

c. embedding said native script corresponding to said call into a service responding to said converted XML document (See Figure 6, 160, shows relational database residing within the server computer receiving requests, wherein “legacy database management system” is deemed to run on the relational database, also see page 2, paragraph 0020); and

d. presenting said converted XML document to said legacy data base management system (See Figure 6, 160, shows relational database residing within the server computer receiving requests, wherein “legacy database management system” is deemed to run on the relational database).

As to claim 16, Roth discloses an apparatus comprising:

a. transmitting means for transmitting an XML document via a publicly accessible digital data communication network (See page 4, paragraph 0056, lines 1-5, also see page 3, paragraph 0044, deemed to show client server connection via Internet);

b. providing means responsively coupled to said transmitting means for providing legacy data base management having an internal format different from XML format (See page 7, paragraphs 0086-0087, wherein “legacy database management system” is deemed to run on the relational database);

c. converting means responsively coupled to said providing means for converting said XML document into said internal format (See page 7, paragraph 0089, wherein “internal format” reads on “SQL”); and

d. embedding means responsively coupled to the component builder for embedding a call to native script into a service for said legacy data base management system (See Figure 6, 160, shows relational database residing within the server computer receiving requests, wherein “legacy database management system” is deemed to run on the relational database, also see page 2, paragraph 0020).

As to claim 17, Roth discloses wherein said providing means further comprises a repository means (See Figure 6, 160, relational database, wherein “repository means” reads on “relational database”).



As to claim 18, Roth discloses further comprising defining means for defining a format of said native service (See Roth page 2, paragraph 0013, also see Roth page 7, paragraph 0086, wherein “internal format” reads on “SQL”, also see page 7, paragraphs 0081-0082).

As to claim 20, Roth discloses wherein said storing means stores said defining means for future use (See page 7, paragraph 0085).

As to claim 21, Roth discloses an apparatus for communicating within a data processing environment comprising:

a. a user terminal (See page 7, paragraph 0087, wherein “terminal” reads on “client computer”) whereby a user can make a data processing service request by transferring an XML message and receive a corresponding data processing response (See Figure 7, process flow diagram, 110, XML send/receive module);

b. a converter which converts said XML message into said data processing service request in a native command language (See page 7, paragraph 0089, wherein “internal format” reads on “SQL”); and

c. a legacy database management system responsively coupled to said user terminal which executes said native command language wherein said service request is honored by execution of an ordered sequence of statements of said native command language (See page 5, paragraphs 0066-0068).

As to claim 23, Roth discloses wherein said user terminal further comprises an industry standard personal computer (See page 3, paragraph 0044, wherein “personal computer” is deemed to be one of “connected group of computers”).

As to claim 24, Roth discloses wherein said legacy database management system further comprises a repository for storage of said ordered sequence of statements of said native command language prior to execution (See page 5, paragraphs 0066-0068, wherein “native command language” reads on “the Operator box” part of SQL language being specified prior to execution of the search).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth (U.S. Pub. No. 2003/0041053 A1) in view of Jacobs (U.S. Patent No. 6,611,843 B1).

As to claim 12, Roth does not teach wherein said converting step includes use of a Document Type Definition corresponding to said XML document.

Jacobs teaches wherein said converting step includes use of a Document Type Definition corresponding to said XML document (See Jacobs figure 6, stage 1, steps, shows “DOM” schema deemed to include Document type definition, also see Jacobs column 4, lines 63-67).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a XML DTD since its an inherit party of the protocol representing a collection of XML markup declarations that, as a collection, defines the legal structure, elements, and attributes that are available for use in a document that complies to the DTD.

As to claim 13, Roth as modified discloses comprising storing said native script in a repository located within said legacy data base management system (See Roth Figure 5, 508, shows “native script” represented by “SQL Statements”, 150, shows “legacy database management system” deemed to be part of “server computer”).

As to claim 14, Roth as modified discloses wherein said native script further comprises said internal format (See Roth page 2, paragraph 0013, also see Roth page 7, paragraph 0086, wherein “internal format” reads on “SQL”).

As to claim 15, Roth as modified discloses wherein said publicly accessible digital data communication network further comprises the Internet (See Roth page 3, paragraph 0044).

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8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth (U.S. Pub. No. 2003/0041053 A1) in view of Dombroski et al. (U.S. Pub. No. 2003/0023463 A1).

As to claim 22, Roth does not teach wherein said legacy database management system further comprises a mainframe computer.

Dombroski et al. teaches wherein said legacy database management system further comprises a mainframe computer (See Dombroski et al. page 6, paragraph 0061).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a legacy DBM (i.e. SQL) running mainframe computers.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the claims of the present application are patentably distinct from those of the co-pending application is acknowledged but does not seem to be persuasive.

The Examiner maintains the provisional double patenting rejection stating that these differences are considered obvious and do not patentably distinguish the overall appearance of the claimed medium and method over copending application Serial No. 10/028,256 specifically claim 1 disclosing that user terminal generates XML request to legacy database management system, then moving on to claims 6, and 11 disclosing a converter in a user terminal for

translating document from XML to internal format. And similarly, with copending application Serial No. 10/027,066.

A nonstatutory double patenting rejection of the obviousness-type applies to claims directed to the same inventive concept with different appearances or differing scope, which are patentably indistinct from each other. Nonstatutory categories of double patenting rejections which are not the “same invention” type may be overcome by the submission of a terminal disclaimer.

An obviousness-type double patenting rejection must be based on the obviousness standard of 35 U.S.C. 103(a). That is, the conflicting inventions must have overall appearances that are basically the same, and the differences between them must either be minor and patentably indistinct or obvious to a designer of ordinary skill in the art in view of analogous prior art or case law. See MPEP 804 [R-3] the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kiernan et al. (U.S. Patent No. 6,934,712 B2) teaches tagging XML query results over relational DBMSS.

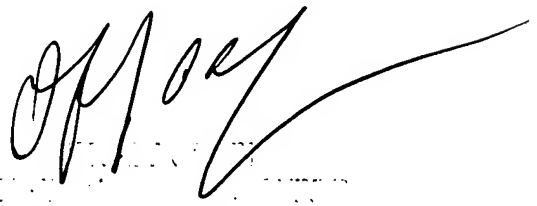
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
December 26, 2005



NEVEEN ABEL-JALIL  
Examiner